

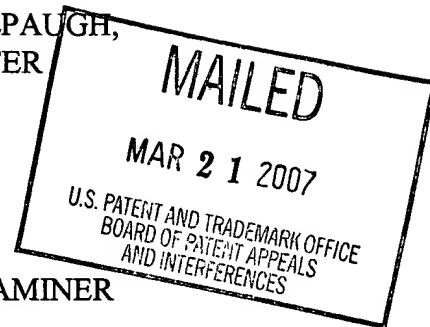
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: BERNARD A. TRAVERSAT, THOMAS E. SAULPAUGH,
MICHAEL J. DUIGOU and GREGORY L. SLAUGHTER

Application No. 09/653,227

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER



The Board of Patent Appeals and Interferences (Board) electronically received this application on February 8, 2007. The application is not ready for review and consideration by the Board for the reasons noted below. Accordingly, the application is herewith being returned to the Examiner to take action consistent with the guidance provided by this order.

BACKGROUND

On October 4, 2006, the Office entered an Examiner's Answer including new grounds of rejection under 35 U.S.C. §§ 101. In response, Appellant filed an Amendment and a Reply under 37 CFR §1.111 on October 16, 2006 requesting that the prosecution of the application be reopened. On October 30, 2006, the Examiner mailed a communication acknowledging receipt of the request to reopen prosecution, withdrawing only the new ground of rejection under 35 U.S.C. § 101 and indicating that "no further response by the examiner is

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deemed necessary.” The Examiner then forwarded the application to the Board of Patent Appeals and Interference for consideration of the appeal.

A reply under 37 CFR § 1.111 requesting that the prosecution of an application be reopened is treated by the Board as a request to withdraw the appeal. 37 C.F.R. § 41.39(b)(1). In addition, 37 CFR § 41.39(b)(1) states that “[a] request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. “

According to 37 CFR § 1.112:

After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action and any comments by an inter partes reexamination requester (§ 1.947), the application or the patent under reexamination will be reconsidered and again examined. The applicant, or in the case of a reexamination proceeding the patent owner and any third party requester, will be notified if claims are rejected, objections or requirements made, or decisions favorable to patentability are made, in the same manner as after the first examination (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111 or § 1.945, with or without amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 41.31 of this title) has been taken (§ 1.116), or in an inter partes reexamination, that it is an action closing prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

The Examiner’s communication mailed on October 30, 2006, does not comply with 37 CFR § 1.112.

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CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner for appropriate action on the following:

- 1) to vacate the Examiner's Communication dated October 30, 2006;
- 2) to "reconsider and again examine" the application consistent with 37 CFR § 1.112 and Office policy; and
- 3) to notify Appellants of the Examiner's reconsideration consistent with 37 CFR § 1.112 and Office policy.

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PJN/dpv

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